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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/067,527

02/04/2002

Yukihiro Takada

FJN-058C1

8309

21323

7590

03/07/2005

EXAMINER

GUPTA, ANISH

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ART UNIT

PAPER NUMBER

1654

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

41

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/067,527	Applicant(s) TAKADA ET AL.	
	Examiner Anish Gupta	Art Unit 1654	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 49-60.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

Continuation of 3. NOTE: The claims have been amended to to recite "a calcium agent suitable for absorpotion by a mammal." This new limitation would require new search and/or new consideration. .

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue for the anticipation rejection, that the calcium recited in the reference are calcium phosphates which are not suitable for absorption. Further, the reference does not teach that the composition is effective in bone strengthening effect. This limitation has been recited not only in the preamble but also the body of the claim. Finally, the although egg shell calcium include calcium phosphate, this as been excluded from the claimed invention because calcium phosphate is not a "calcium agent suitable for absorption by a mammal."

For the obviousness rejection, Applicants argue that the ratios were determined to be essential to the effectiveness of the compound in strengthening bone. Further, Cioca does not teach that the composition can be used for bone strengthening. Thus, one would not be motivated to optimize the ratios for bone strengthening.

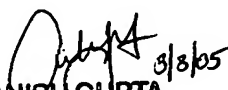
Applicants arguments have been considered but have not been found persuasive.

First, the amendment to the claims have not been entered and those arguments with regards to the amendment have not been addressed. It should be noted however, that calcium phosphate is suitable for absorption by a mammal. However, the reference relied upon by Applicants to establish inability of calcium phosphate absorption is limited to human consumption, whereas the claims are open to consumption by any mammal. Applicants have not established that absorption seen in humans is similar to other mammals such as suckling pigs, the subject of the recited reference. It is known in the art that animal feed often contains calcium phosphate and is absorbable by mammals such as sheep and pigs.

Applicants have argued that the prior art does not teach the ability to strengthen bones. Such a use for the composition, weather in the body of the claim or preamble is intended use. recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

Finally, the optimization of the dosage need not be limited to strengthening of bones. The reference teaches a composition for the nutritional purposes and thus one would be motivated to optimize the ratio for that purpose. As a final note, Applicants have recited that "[a]s exemplified in the specification, such ratios were determined to be essential to the effectiveness of the compound in strengthening bone." Claim 1 of the instant application does not claim any ratios. If the ratios are indeed essential, then it seems the base claims should recite this ESSENTIAL element to allow one of ordinary skill in the art to practice the claimed invention.

All rejections are maintained.


ANISH GUPTA
PATENT EXAMINER